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Cynthia L. Foulke
NATIONAL STARCH AND CHEMICAL COMPANY
10 Finderne Avenue
Bridgewater, NJ 08807-0500

EXAMINER

SCHATZ, CHRISTOPHER T

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.



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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/613,409
Filing Date: July 03, 2003
Appellant(s): GOOD ET AL.

Sun Hee Lehmann
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 06/04/2010 appealing from the Office action mailed 01/05/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Rejected: Claims 1-8, 10, 12, 13, 22 and 25-29.

Pending: Claims 1-8, 10, 12, 13, 22 and 25-29.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

The examiner has no comment on the appellant's statement of the grounds of rejection to be reviewed on appeal. Every ground of rejection set forth in the Office action from which the appeal is taken (as modified by any advisory actions) is being maintained by the examiner except for the grounds of rejection (if any) listed under the

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subheading "WITHDRAWN REJECTIONS." New grounds of rejection (if any) are provided under the subheading "NEW GROUNDS OF REJECTION."

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

EP 0934990	MEHAFFY ET AL.	8-1999
US 5,827,913	BAETZOLD ET AL.	10-1998

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-5, 8, 10, 12, 13, 22 and 25-29 rejected under 35 U.S.C. 103(a) as being unpatentable over Mehaffy et al. (EP 0934990).

At the outset, the appellant is notified that the limitation in the independent claims stating that the adhesive "is applied at a temperature of below 250 °F" is a method limitation and thus does further limit the claim because method limitations do not further limit product claims. Claims 1 and 26 only require an adhesive that is capable of being

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applied at less than 250 °F, with a viscosity within appellant's claimed range at a temperature of below 250 °F and a heat stress value that is separated from the application temperature by less than 100 °F.

As to claims 1-3 and 22, paragraph 33 discloses an adhesive that is applied at 200 °F, wherein the heat stress value is separated by 90 °F or less from the application temperature. Specifically, paragraph 0033 states that the adhesive can be applied at 200°F and that "a bond formed by two pieces of corrugated case substrate held together by a 1/2" by 2" compressed bead can maintain a cantilever stress load of 2 to 2.5 psi for 24 hours at temperatures at or above 115 degree F." Examiner interprets 115°F as the heat stress value. The reference does not explicitly recite the viscosity of the adhesive at 200 °F. However, the adhesive disclosed in the reference and the adhesive disclosed in the appellant's specification are of substantially identical compositions. More specifically, appellant states that the adhesive of the instant application comprises: EVA copolymer from about 10% to 60%, a tackifying component with a Ring and Ball softening point between 70°C and 150°C, and paraffin wax with a melting point between 140 °C and 160 °C from 10% to 60% (pages 9-11). Appellant should note that Mehaffy et al. discloses a hot melt adhesive with the same components and composition (paragraphs 0009-0018, 0029). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art that the viscosity of the hot melt adhesive at 200 °F is within the appellant's claimed range because the adhesive in the reference is substantially similar to the adhesive disclosed by the appellant. The appellant is referred to MPEP. 2112 (V).

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As to claims 4 and 5, at the time of the invention it would have been obvious to a person of ordinary skill in the art that the adhesive disclosed by Mehaffy et al. would have the same crystallization properties and exhibit the same viscosity change as claimed by the appellant in claims 4 and 5 because Mehaffy discloses the same adhesive as the instant application. As to claim 8, Mehaffy et al. discloses an article of manufacture comprising the adhesive of claim 1 (paragraph 0034). As to claim 10, Mehaffy et al. discloses the article of manufacture is a carton, case, tray or bag (paragraph 0034). As to claims 12 and 13, Mehaffy et al. discloses a packaged food article contained within a carton, case, tray or bag wherein the carton, case, tray or bag contains the adhesive of claim 1 (paragraph 0034). As to claim 25, Mehaffy et al. discloses an adhesive comprising an ethylene n-butyl acrylate copolymer (0021). As to claim 26, the appellant is referred to the discussion of claims 1, 4 and 5 for the reasons as to the why the reference renders the limitations of the claim obvious. As to claim 27, Mehaffy et al. discloses an adhesive comprising 20 wt % of an ethylene n-butyl acrylate copolymer and 10 wt % of an ethylene vinyl acetate copolymer (0025 and 0026). As to claims 28 and 29, the appellant is referred to the discussion of claims 2 and 3 above.

3. Claims 6 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mehaffy et al. as applied above, and further in view of Baetzold et al. '913.

Mehaffy et al. discloses a hot melt adhesive as stated above, and the reference further discloses that "other additives" can be added depending on the end use of said adhesive. The reference is silent as to whether or not said additives comprise a fragrance or an energy-absorbing ingredient. Baetzold discloses a hot melt adhesive

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which can be used in packaging (column lines 10-12), and further discloses that the presence of fragrances and energy absorbing ingredients is well known in the art (abstract, column 4, lines 17-31). Therefore, at the time of the invention it would have been obvious to a person of ordinary skill in the art to add a fragrance and/or an energy-absorbing ingredient to the hot melt adhesive of Mehaffy et al. because the use of said ingredients is well known as taught by Baetzold et al.

(10) Response to Argument

The appellant's arguments are focused on the disclosure of page 7, Table I of Mehaffy. The appellant should note that the compounds and properties disclosed in Table I are only exemplary, and the disclosure of Mehaffy is by no means limited to the disclosure of Table I. Mehaffy even says that the examples "are provided for illustrative purposes only" (paragraph 0035).

The examiner's rejection is not based on Table I of Mehaffy. Rather, the rejection is based on paragraph 0033, which clearly discloses a hot melt adhesive composition that is applied at 200 °F and having a bonded heat stress value of 115 °F which is separated from the application temperature by less than 100 °F. The rejection is also based on the fact that the composition of the appellant's compound and the composition of Mehaffy's compound are substantially similar, and thus will have the same physical properties, such as viscosity, application temperature, heat stress value, crystallization time, etc. The appellant has not refuted this statement by the examiner. Instead the appellant has simply stated that the examiner's position that because Mehaffy discloses an adhesive with the same composition as the adhesive of the instant application

Mehaffy's adhesive meets the limitations of appellant's claims is without merit. This statement is not sufficient to overcome appellant's burden as required by MPEP 2112 (V). The examiner has provided reasoning and/or evidence that shows inherency as required by MPEP 2112 (V). The burden is thus shifted to the appellant to show otherwise. A statement that says the examiner's assertion is without merit is not sufficient to overcome the appellant's burden as required by MPEP 2112 (V).

Appellant's discussion of Table I in Mehaffy does not amount to a showing by the appellant that there is an unobvious difference between Mehaffy and the appellant's claimed adhesive because Table I is again only for illustrative purposes. The appellant has not addressed Mehaffy's disclosure in paragraph 0033..

The appellant states that "Applicants disagree with the Office's assertion that if the adhesives reported in Table I were applied at 200°F, the resultant difference between the application temperature and the heat stress would be less than 100°F". With all due respect to the appellant, this is not what the examiner said (While the appellant cites the Office Action dated June 9, 2010, the examiner believes that the appellant intended to cite the Office Action dated June 9, 2009, as there is no Office Action dated June 9, 2010). The examiner simply stated that it would have been obvious to a person of ordinary skill in the art that the viscosity of the hot melt adhesive at 200 °F is within the appellant's claimed range because the composition of the adhesive in the reference is substantially similar to the composition of the adhesive disclosed by the appellant.

Although the disclosure of Table I is not relied by the examiner for the rejection, it should be noted that the appellant has not proved that the viscosity of Mehaffy's adhesive will increase 40% in viscosity for every 25 °F decrease in temperature. Appellant's equation and calculations are for a general polymer only, and not specific to the specific compositions disclosed by Mehaffy. How viscosity changes as a function of temperature is dependent upon the specific composition of the polymer, and appellant has presented no evidence that a polymer with Mehaffy's specific composition will increase 40% in viscosity for every 25 °F decrease in temperature. Nonetheless, even if the appellant does prove such, Mehaffy's adhesive still meets the limitations of the claims because the disclosure of Mehaffy is not limited to Table I, and the examiner not relying on Table I for the rejection.

With respect to appellant's arguments directed at Baetzold, said arguments rely on the appellant's arguments directed at Mehaffy, which have been addressed above.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/CHRISTOPHER SCHATZ/
Examiner, Art Unit 1791

/Richard Crispino/
Supervisory Patent Examiner, Art Unit 1791

Conferees:

Richard Crispino
/R. C./
Supervisory Patent Examiner, Art Unit 1791

/Christopher A. Fiorilla/
Chris Fiorilla
Supervisory Patent Examiner, Art Unit 1700

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